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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/581,881	06/06/2006	Satoshi Niwano	2006_0823A	3935

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WENDEROTH, LIND & PONACK L.L.P.
1030 15th Street, N.W.
Suite 400 East
Washington, DC 20005-1503

EXAMINER
RAVETTI, DANTE

ART UNIT	PAPER NUMBER
3685	

NOTIFICATION DATE	DELIVERY MODE
12/27/2011	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ddalecki@wenderoth.com
eoa@wenderoth.com

	Application No.	Applicant(s)
Office Action Summary	10/581,881	NIWANO ET AL.
	Examiner	Art Unit	
	DANTE RAVETTI	3685	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>26 October 2011</u>.

2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.

3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on _____ ; the restriction requirement and election have been incorporated into this action.

4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

5) ☒ Claim(s) <u>1-35</u> is/are pending in the application.

   5a) Of the above claim(s) <u>1-23</u> is/are withdrawn from consideration.

6) ☐ Claim(s) _____ is/are allowed.

7) ☒ Claim(s) <u>24-35</u> is/are rejected.

8) ☐ Claim(s) _____ is/are objected to.

9) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

10) ☐ The specification is objected to by the Examiner.

11) ☒ The drawing(s) filed on <u>6/6/2006</u> is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

12) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a) ☒ All b) ☐ Some * c) ☐ None of:

   1. ☒ Certified copies of the priority documents have been received.

   2. ☐ Certified copies of the priority documents have been received in Application No. _____ .

   3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ .

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____ .

DETAILED ACTION

Acknowledgements

1.　　This communication is in response to the Application No. 10/581,881

filed on 26 October 2011.

2.　　Claims 24-35 are currently pending and have been fully examined.

3.　　Claims 1-23 have been cancelled by the Applicant.

4.　　For the purpose of applying the prior art, PreGrant Publications will be

referred to using a four digit number within square brackets, e.g. [0001].

Response to Applicant's Amendments/Remarks

5.　　Applicant's response, filed on 26 October 2011, has fully been considered, but is

moot in light of new grounds of rejection.

　　　In light of Applicant's choice to pursue system claims, Applicants are also

reminded that functional recitations using the word "for," "adapted to", "configured to," or

other functional terms (e.g. see claim 24 which recites "...processor programmed to

operate as...;") have been considered but are given little patentable weight[1] because

they fail to add any structural limitations and are thereby regarded as intended use

language.　To be especially clear, all limitations have been considered. However a

recitation of the intended use in a system claim must result in a structural difference

between the claimed system and the prior art in order to patentably distinguish the

claimed system from the prior art.

　　　Claims 27-29, 32 and 34 contains similar language found in claim 24.

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[1] See e.g. In re Gulack, 703 F.2d 1381, 217 USPQ 401,404 (Fed. Cir. 1983)(stating that although all limitations must
be considered, not all limitations are entitled to patentable weight.).

Examiner would also like to point out that Official Notice was used in the previous office action mailed on 8 March 2010 to indicate that *whose format is converted by the format conversion unit based on the digital signature* were old and well known in the art. Since applicant has not attempted to traverse this Official Notice statement, Examiner is taking the common knowledge or well-known statement to be admitted prior art.[2]

Claim Rejections - 35 USC § 103

6.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7.   Claims 24-25, 29-30, 32, 34 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakahara et al., (US 2003/0048907) ("*Nakahara*") and in view of Ferrante et al., (US 6,915,278) ("*Ferrante*") and in view of Demartini et al., (US 2004/0236717) ("*Demartini*") and in further view of McKune (US 2002/0169974) ("*McKune*").

As to Claims 24, 29, 32, 34 and 35:

Nakahara teaches substantially as claimed:

a license management server ([0099], Figure 6);

and a terminal device (Figure 6);

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wherein the license management server includes at least one processor programmed to operate as: (Figure 2);

a first license generation unit generating, in a first format, a first license for controlling content use in the terminal device ([0011]);

a specification information receiving unit receiving an input of format specification information that is an instruction, to the terminal device, for converting a format of a second license to the first format ([0109], Figure 17);

and a specification information sending unit sending the received format specification information to the...server, wherein the...server includes at least one processor programmed to operate as: (Figure 17);

and wherein the terminal device includes at least one processor programmed to operate as: a format conversion unit obtaining the second license from the relay server ([0109], Figure 17);

Nakahara does not expressly teach _a relay server_; however, the Examiner takes Official Notice that "_a relay server_" is old and well known."[3] Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of _Nakahara_ with the commonly recognized practice of "_a relay server_" because servers are often used to process user requests.

Nakahara does not expressly teach _depending on a status of a transmission path to the terminal device_; however, the Examiner takes Official Notice that _depending on a status_

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[3] **Spencer et al.,** (US 2003/0014630) ("_Spencer_").[0082] At the application ▨▨▨▨▨▨▨ into a master license that is distributed to the pass-through device together with the encrypted audio file or audio files (235). The master license is only usable by the pass-through device, so if a user tries to copy the downloaded audio file (with or without the master license) to a different computer or pass-through device, the copied audio file will not be usable on that target device. Optionally the master license may contain instructions that make the audio files playable on the pass-through device, or instructions that allow the user to burn a compact disk from the received audio files.

of a transmission path to the terminal device is old and well known.[4] Therefore, it would

have been obvious to one of ordinary skill in the art at the time of the invention to

combine the teachings of *Nakahara* with the commonly recognized practice of

depending on a status of a transmission path to the terminal device because

determining "path" status before a transmission has been performed aids in the insuring

that data is properly transmitted, when required.

Nakahara does not expressly teach:

> and converting the format of the second license into the first format, according to
> the format specification information added to the second license;

However, *Ferrante* expressly teaches:

> and converting the format of the second license into the first format, according to
> the format specification information added to the second license; 9Col. 3, lines
> 15-35);

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the

invention to modify *Nakahara* to include the features of *Ferrante* because applying a

known technique to a known device, method, or product ready for improvement to yield

predictable results.

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[4] **Tanino et al.,** (US 2004/0073648) [0121] FIG. 14 illustrates an example of device information stored in the server
21. This information contains an equipment operational status 201 indicating the server operational status, a
configuration application 202 indicating the application program executed in the server, a transmission line for use
203 which is the transmission line used by the server during execution of the configuration application, a transmission
line operational status 204 showing whether the transmission line for use is available, an HBA for use 205 indicating
the host bus adapter used by the transmission line for use 203, an HBA status 206 indicating the status of the HBA
for use 205, a target storage 207 to which the HBA for use 205 will be eventually connected, a connection module
208 used for connection to the target storage 207 and logical addresses (LUN) 209 which are numbers representing
the access domain in the target storage 207.

The combination of *Nakahara/Ferrante* *discloses as discussed above; however, the*

combination of *Nakahara/Ferrante* *does not expressly disclose:*

> a modification detection information generation unit generating a digital signature for detecting a modification of the first license; and

> sending the generated digital signature to the relay server;

> a second license generation unit (i) generating, in a second format, the second license by adding, to the first license, the digital signature for detecting the modification of the first license, the second format being different from the first format, and (ii) adding, to the generated second license, the format specification information received by the license management server;

> a judgment unit judging a presence or absence of the modification of the first license using the digital signature for detecting the modification of the first license having a format converted from the second format into the first format by the format conversion unit;

However, *Demartini* expressly teaches:

> a modification detection information generation unit generating a digital signature for detecting a modification of the first license ([0113]); and

> a second license generation unit (i) generating, in a second format, the second license by adding, to the first license, the digital signature for detecting the modification of the first license, the second format being different from the first format, and (ii) adding, to the generated second license, the format specification information received… (Figure 8);

> a judgment unit judging a presence or absence of the modification of the first license using the digital signature for detecting the modification of the first license having a format converted from the second format into the first format by the format conversion unit ([0038], [0113], [0115]);

> when the judgment unit judges that no modification is made ([0038], [0113], [0115]);

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the

invention to modify the combination of *Nakahara/Ferrante* to include the features of

Demartini because applying a known technique to a known device, method, or product

ready for improvement to yield predictable results.

The combination of *Nakahara/Ferrante/Demasrtini* discloses as discussed above;

however, the combination of *Nakahara/Ferrante/Demartini* does not expressly disclose:

>   sending the generated digital signature to the...server;

>   and a use unit using the content according to the first license...

However, *McKune* expressly teaches:

>   sending the generated digital signature to the...server ([0018]);

>   and a use unit using the content according to the first license...([0121]);

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the

invention to modify the combination of *Nakahara/Ferrante/Demartini* to include the

features of *McKune* because applying a known technique to a known device, method, or

product ready for improvement to yield predictable results.

As to Claims 25 and 30:

Nakahara teaches substantially as claimed:

>   and instructs the...server to generate the second license ([0109], Figure 17);

Nakahara does not expressly teach *a relay*; however, the Examiner takes Official Notice

that "*a relay*" is old and well known."[5] Therefore, it would have been obvious to one of

ordinary skill in the art at the time of the invention to combine the teachings of *Nakahara*

with the commonly recognized practice of "*a relay*" because servers are often used to

process user requests.

Nakahara does not expressly teach, *when (i) a frequency band of the transmission path*

is narrower than a frequency band predetermined by a characteristic of the transmission

path, or (ii) a communication speed of the transmission path is slower than a

communication speed predetermined by the characteristic of the transmission path;

however, the Examiner takes Official Notice that *when (i) a frequency band of the*

transmission path is narrower than a frequency band predetermined by a characteristic

of the transmission path, or (ii) a communication speed of the transmission path is

slower than a communication speed predetermined by the characteristic of the

transmission path is old and well known.[6]

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[5] **Spencer et al.,** (US 2003/0014630) ("*Spencer*").[0082] At the application ▨▨▨▨▨▨▨▨▨▨▨▨▨▨▨▨
into a master license that is distributed to the pass-through device together with the encrypted audio file or audio files
(235). The master license is only usable by the pass-through device, so if a user tries to copy the downloaded audio
file (with or without the master license) to a different computer or pass-through device, the copied audio file will not be
usable on that target device. Optionally the master license may contain instructions that make the audio files playable
on the pass-through device, or instructions that allow the user to burn a compact disk from the received audio files.

[6] **Tanino et al.,** (US 2004/0073648) [0121] FIG. 14 illustrates an example of device information stored in the server
21. This information contains an equipment operational status 201 indicating the server operational status, a
configuration application 202 indicating the application program executed in the server, a transmission line for use
203 which is the transmission line used by the server during execution of the configuration application, a transmission
line operational status 204 showing whether the transmission line for use is available, an HBA for use 205 indicating
the host bus adapter used by the transmission line for use 203, an HBA status 206 indicating the status of the HBA
for use 205, a target storage 207 to which the HBA for use 205 will be eventually connected, a connection module
208 used for connection to the target storage 207 and logical addresses (LUN) 209 which are numbers representing
the access domain in the target storage 207.

The combination of *Nakahara/Ferrante* discloses as discussed above; however, the combination of *Nakahara/Ferrante* does not expressly disclose:

 the modification detection information generation unit;

 sends the generated digital signature to the relay server;

However, *Demartini* expressly teaches:

 the modification detection information generation unit ([0113]);

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the combination of *Nakahara/Ferrante* to include the features of *Demartini* because applying a known technique to a known device, method, or product ready for improvement to yield predictable results.

The combination of *Nakahara/Ferrante/Demasrtini* discloses as discussed above; however, the combination of *Nakahara/Ferrante/Demartini* does not expressly disclose:

 sends the generated digital signature to the relay server;

However, *McKune* expressly teaches:

 sends the generated digital signature to the relay server ([0018]);

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the combination of *Nakahara/Ferrante/Demartini* to include the features of *McKune* because applying a known technique to a known device, method, or product ready for improvement to yield predictable results.

As to Claims 26 and 31:

As to, *wherein the second license generation unit generates the second license*

so that a data size of the second license generated in the second format is smaller than

a data size of the first license generated in the first format, clauses (e.g. whereby,

thereby, wherein) that merely states the result of the limitation(s) of a claim(s) does not

limit the scope of the claim(s).[7]

As to Claim 27:

Nakahara teaches substantially as claimed:

> wherein the at least one processor of the… is programmed to operates as a
> second sending unit[8] sending the second license to the terminal device via the
> transmission path… ([0099], Figure 6); and

> wherein the at least one processor of the terminal device is programmed to
> obtain the second license from the second sending unit ([0011]);

Nakahara does not expressly teach *relay server*; however, the Examiner takes Official

Notice that "*relay server*" is old and well known."[9] Therefore, it would have been

obvious to one of ordinary skill in the art at the time of the invention to combine the

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[7] MPEP §2111.04[R-3]; MPEP §2106 II C; §2106.01; MPEP §2114;

[8] In re Harza, 124 USPQ 378 Mere duplication of parts has no patentable significance unless new and unexpected result is produced;

[9] **Spencer et al.,** (US 2003/0014630) ("*Spencer*").[0082] At the application ░░░░░░░░░░░░░░░░░░░░░ into a master license that is distributed to the pass-through device together with the encrypted audio file or audio files (235). The master license is only usable by the pass-through device, so if a user tries to copy the downloaded audio file (with or without the master license) to a different computer or pass-through device, the copied audio file will not be usable on that target device. Optionally the master license may contain instructions that make the audio files playable on the pass-through device, or instructions that allow the user to burn a compact disk from the received audio files.

teachings of _Nakahara_ with the commonly recognized practice of "_relay server_" because servers are often used to process user requests.

Nakahara does not expressly teach _different from the transmission path in the case of using the license management server_; however, the Examiner takes Official Notice that _different from the transmission path in the case of using the license management server_ is old and well known.[10] Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of _Nakahara_ with the commonly recognized practice of _different from the transmission path in the case of using the license management server_ because determining "path" status before a transmission has been performed aids in the insuring that data is properly transmitted, when required.

As to Claim 28:

Nakahara teaches substantially as claimed:

> further comprising a plurality of servers, each of the plurality of servers being the… server, wherein the at least one processor of each of the plurality of…servers is programmed to operate as an "n"th license generation unit generating an "n"th ("n" is a natural number that is 2 or greater) license, in an "n"th format, by adding, to the first license ([0109], Figure 17);

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[10] **Tanino et al.,** (US 2004/0073648) [0121] FIG. 14 illustrates an example of device information stored in the server 21. This information contains an equipment operational status 201 indicating the server operational status, a configuration application 202 indicating the application program executed in the server, a transmission line for use 203 which is the transmission line used by the server during execution of the configuration application, a transmission line operational status 204 showing whether the transmission line for use is available, an HBA for use 205 indicating the host bus adapter used by the transmission line for use 203, an HBA status 206 indicating the status of the HBA for use 205, a target storage 207 to which the HBA for use 205 will be eventually connected, a connection module 208 used for connection to the target storage 207 and logical addresses (LUN) 209 which are numbers representing the access domain in the target storage 207.

the "n"th format being different from the first format, and wherein the format conversion unit of the terminal device obtains the "n"th license from one…server of the plurality of…servers and converts the format of the "n"th license into the first format ([0109], Figure 17);

Nakahara does not expressly teach *a relay*; however, the Examiner takes Official Notice that "*a relay*" is old and well known."[11] Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of *Nakahara* with the commonly recognized practice of "*a relay*" because servers are often used to process user requests.

Nakahara, does not expressly teach:

the digital signature for detecting the modification of the first license;

However, *Demartini* expressly teaches:

the digital signature for detecting the modification of the first license ([0113]);

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the combination of *Nakahara/Ferrante* to include the features of *Demartini* because applying a known technique to a known device, method, or product ready for improvement to yield predictable results.

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[11] **Spencer et al.,** (US 2003/0014630) ("*Spencer*").[0082] At the application ▓▓▓▓▓▓▓▓▓▓▓▓▓ into a master license that is distributed to the pass-through device together with the encrypted audio file or audio files (235). The master license is only usable by the pass-through device, so if a user tries to copy the downloaded audio file (with or without the master license) to a different computer or pass-through device, the copied audio file will not be usable on that target device. Optionally the master license may contain instructions that make the audio files playable on the pass-through device, or instructions that allow the user to burn a compact disk from the received audio files.

Conclusion

8.   The prior art made of record and not relied upon is considered pertinent to

Applicant's disclosure.

Spencer et al., (US 2003/0014630) ("*Spencer*").
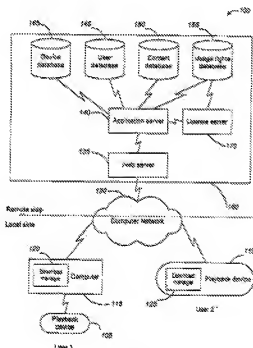
FIG. 1

[0082] At the application ▓▓▓▓▓▓▓▓▓▓▓▓▓▓▓▓▓▓▓▓▓▓▓▓ into a master license that is distributed to the pass-through device together with the encrypted audio file or audio files (235). The master license is only usable by the pass-through device, so if a user tries to copy the downloaded audio file (with or without the master license) to a different computer or pass-through device, the copied audio file will not be usable on that target device. Optionally the master license may contain instructions that make the audio files playable on the pass-through device, or instructions that allow the user to burn a compact disk from the received audio files.

Tanino et al., (US 2004/0073648) [0121] FIG. 14 illustrates an example of device information stored in the server 21. This information contains an equipment operational status 201 indicating the server operational status, a configuration application 202 indicating the application program executed in the server, a transmission line for use 203 which is the transmission line used by the server during execution of the configuration application, a transmission line operational status 204 showing whether the transmission line for use is available, an HBA for use 205 indicating the host bus adapter used by the transmission line for use 203, an HBA status 206 indicating the status of the HBA for use 205, a target storage 207 to which the HBA for use 205 will be eventually connected, a connection module 208 used for connection to the target storage 207 and logical addresses (LUN) 209 which are numbers representing the access domain in the target storage 207.

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Mr. Dante Ravetti whose telephone number is (571) 270-3609. The examiner can normally be reached on Monday – Thursday 9:00am-5:00pm.

If attempts to reach examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Calvin Hewitt may be reached at (571) 272-6709. The fax phone number for the organization where this application or proceeding is assigned is (571) 270-4609.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system see http://pair-direct.uspto.gov. Should you have questions on access to the private PAIR system, please contact the Electronic Business Center (EBC) at 1-(866)

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9199 (IN USA or CANADA) or 1-(571) 272-1000.

/Dante Ravetti/
Examiner, Art Unit 3685
12/12/2011

/ANDREW J. FISCHER/
Supervisory Patent Examiner, Art Unit 3621